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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,757	11/20/2000	John J. Chen	S63.2-9494	8168

490 7590 02/04/2003

VIDAS, ARRETT & STEINKRAUS, P.A.
6109 BLUE CIRCLE DRIVE
SUITE 2000
MINNETONKA, MN 55343-9185

EXAMINER

CHATTOPADHYAY, URMI

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 02/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,757

Applicant(s)

CHEN ET AL.

Examiner

Urmi Chattopadhyay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed 11/6/02 has been entered as Paper No. 5. Claims 1-4, 6 and 9-12 have been amended and new claim 13 has been added.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: claim 2 requires that the second material be smoother than the first material. There is no support for this claim in the specification. Because this limitation was originally presented in the claims, applicant is required to include it into the written specification.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. New claim 13 requires that the at least one stent retaining sleeve have a uniform thickness. There is no support for this in the written disclosure, nor is it clearly depicted

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in the figures. See specifically Figure 1, element 22 for the stent retaining sleeve not having a uniform thickness, wherein the second end is shown as being thinner than the first end.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-5 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Willard et al. (USPN 5,980,530).

Willard et al. discloses a stent delivery system with all the elements of claims 1, 11 and 12. See Figure 1 for catheter (10) with stent mounting region (14), stent (20) disposed about stent mounting region, at least one stent retaining sleeve (combination of 22 and 34) with first end overlying one end of the stent (30) and second end engaged to a portion of the catheter adjacent to the stent mounting region. The outside surface (22) of the stent retaining sleeve (22 and 34) is composed of a first material, the inside surface (34) of the stent retaining sleeve (22 and 34) is composed of a second material, wherein the second material has a higher durometer value than the first material. See column 3, lines 48-53 and lines 60-65 for first material being of elastomer and second material being made of a metal, for example, which would inherently have a higher durometer value than the elastomer.

With respect to claim 2, it appears from the specification on page 5, lines 15-17 that because a stent retaining sleeve with a greater hardness provides the sleeve with lower frictional engagement to the stent, the sleeve would be "smoother". Following this logic, as interpreted by the Examiner, because the second material of Willard et al. is harder than the first material, the second material will be smoother.

With respect to claims 9, see column 3, lines 47-49 for first material being constructed from polyurethane. With respect to claim 10, see column 4, line 24-26 for second material being constructed from polyamide. Applicant's specification on pages 7-8, lines 5-5 give polyurethane and polyamide as examples of first and second materials, respectively, that would be appropriate choices for this application. Therefore, it is inherent that these materials would meet the durometer values required in claims 3 and 4.

Claim 5, see Figure 1 and column 3, lines 59-60 for inside surface (34) comprising the second material.

Allowable Subject Matter

7. Claim 6 is allowed.

Response to Arguments

8. Applicant's arguments filed 11/6/02 have been fully considered but they are not persuasive.

Applicant argues that amended claims 1, 11 and 12 require the inner surface be comprised of the second material, which distinguishes over Willard et al. where only the portion

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of the inside surface comprised of the ring material comprises the second material. Examiner disagrees because the exact wordings of these amended claims do not overcome the Willard et al. prior art rejection. The limitation of "the inside surface being composed of a second material" is broadly interpreted and does not preclude only a portion of the inside surface being of a second material. Examiner would like applicant to note that the elected species of Figure 1 shows only a portion of the inside surface of a second material, while the non-elected species of Figure 2 shows the "entire inside surface" of the sleeve composed of the second material (see page 8, lines 19-20 of the specification). The claims of this current application must be directed to the elected species of Figure 1.

Conclusion

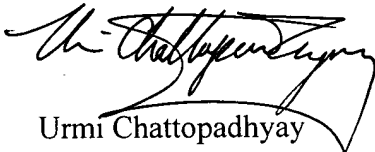
9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Urmi Chattopadhyay whose telephone number is (703) 308-8510 and whose work schedule is Monday-Friday, 9:00am – 6:30pm with every other Friday off. The examiner's supervisor, Corrine McDermott, may be reached at (703) 308-2111. The group receptionist may be reached at (703) 308-0858.

Should the applicant wish to send a fax for official entry into the file wrapper the Group fax number is (703) 305-3590. Should applicant wish to send a fax for discussion purposes only, the art unit fax number is (703) 308-2708.




Urmi Chattopadhyay

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January 28, 2003



David J. Isabella
Primary Examiner